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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,605	12/27/2000	Linda Luu	42390.P1785C3D1	2993

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EXAMINER

WANG, WAYLON

ART UNIT PAPER NUMBER

2127

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,605

Applicant(s)

LUU, LINDA

Examiner

Waylon Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 21-40 are presented for examination.
2. The specification is objected to because applicant had indicated in the paper filed on 12/27/00 that this application is a continuation application of 09/127,116, 08/859,277 and 08/130,097. Applicant is required to incorporate this information in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.
3. In the 'Utility Patent Application Transmittal' form, applicant indicated the current application of 09/752,605 is the continuation of prior application number of 09/127,116, which is the continuation of prior application number 08/859,277, and is the continuation of prior application of 08/130,097. However, applicant marked this current application as 'Divisional'. Applicant is required to correct status of application as a 'Continuation' application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 21,26,31,32,36 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,324,690 and claim 24 of U.S. Patent No. 5,860,012. Although the conflicting claims are not identical, they are not patentably distinct from each other because they all comprise source workstation for generating personality file that describing installation parameters for a target workstation to install an application software package, and using a pre and post-snapshot of the software on the source workstation to generate application installation package. The difference between U.S. Patent No. 6,324,690, U.S. Patent No. 5,860,012 and this case is the generation of the application installation package is based on the differences of the pre and post snapshot.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the application installation package should be generated from the differences of the pre and post-snapshot in order to distinguish what to install in the target workstation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al (U.S. Patent 5,247,683) in view of Rolf Petter Halle 'RE: DOS: Script to edit WIN.INT?' E-mail, Newsgroups:comp.lang.perl's, dated on 05/28/1993.

6. As per claim 21, Holmes et al teach the invention substantially as claimed including a computer-implemented method:

generating a personality file for a target workstation (col 5, lines 21-31), the personality file describing installation parameters for an application software package (col 2, lines 50-60) and the target workstation (col 5, lines 25-31);

generating an application installation package for the application software package on a source workstation (col 5, lines 42-68, col 6, lines 1-9); and

the target workstation receiving the application installation package (col 5, lines 33-36) and installing the application software package based on the

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application installation package and the personality file (col. 4, lines 6-11, col 6, lines 3-9).

7. Holmes et al fail to teach the pre-snapshot and post-snapshot, and generating the application installation package from the snapshots on source workstation.

8. Rolf Petter Halle teaches the method of using a pre-installation system snapshot of software on the source workstation (p.2, lines 17-29) and a post-installation system snapshot of the software on the source workstation to generate the application installation package (p.2, lines 23-28).

9. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Holmes and Rolf Petter Halle because Rolf Petter Halle's pre and post snapshot would improve the accuracy of Holmes et al's system by identifying the differences of pre and post snapshots to generate more precise installation package to complete the installation of the software application over the target workstations.

10. As per claim 22, Rolf Petter Halle teaches the pre-installation and post-installation system snapshots of the software on the source workstation (p.2, lines 17-29); and

comparing the pre-installation system snapshot with the post-installation system snapshot (p.2, lines 17-29).

11. As per claim 23, Holmes et al and Rolf Petter Halle did not specifically teach scheduling the installation of the software package. However, Holmes et al disclosed that his system will install the software to the target computer once the configuration building file can reflect the configuration requirement by the software file (col 10, lines 38, 57-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the scheduling in Holmes et al system because it would allow the target computer knows exactly the time when the software will be installed.

12. As per claim 24, Holmes et al disclosed the application installation package comprises a plurality of instructions for installing the application software package on the target workstation (col. 5, lines 21-31).

13. As per claim 25, Holmes et al and Rolf Petter Halle did not specifically teach deinstalling the application software from the source workstation. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include deinstalling of application in Holmes et al and Rolf Petter Halle's system because it would improve the integrity of their system by having the capability of undue/deinstall certain software if it's no longer needed/used by the target computer.

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14. As to claims 26-30, they are system claims of claims 21-25. Therefore, they are rejected for the same reason as claims 21-25 above.

15. As to claim 31, it is a program claim of claim 21. Therefore, it is rejected for the same reason as claim 21 above.

16. As to claim 32, it is rejected for the same reason as claim 21 above.

Holmes et al and Rolf Petter Halle did not specifically disclose that the pre and post snapshots are the state of the source workstation. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that in fact the information of the snapshots of Rolf Petter Halle is the state of the source workstation. It would have been obvious to one of ordinary skill in the art that only by knowing the state of the workstation would allow Rolf Petter Halle's system to generate the precise application installation package to be used by the target workstation.

17. As to claims 33-35, it is rejected for the same reason as claims 22-25 above.

18. As to claims 36-40, they are system claims of claims 32-35. Therefore, they are rejected for the same reason as claims 21-25 and 32-35 above.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Publication of 'Maintenance of system software on a wide area network of mainframes' by authors of Wolfgor and Mamram in May, 1991, pp 113-119 mentioned a method to distribute software changes in the remote sites.

The publication of 'WinInstall installs Windows apps from central location' by T. Busse, INFOWORLD, p. 54, May 24, 1993 indicated an software distribution system for Windows applications was used to enable network administrators to install, remove and distribute applications from a central location to each PC on the LAN.

The publication of 'WinInstall Sends Applications As E-Mail Attachments' by Brad Grimes, PC Magazine, p. 66, July, 1993, showed it not only does the WinInstall to control installations and upgrades of Windows applications across any network, but it can do it using electronic mail.


20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Waylon Wang whose telephone number is (703) 605-4320 or new telephone number (571) 272-3775 effective 10/15/2004. The examiner can normally be reached on Monday-Thursday from 8:30AM-18:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng Ai An can be reached on (703) 305-9678 or (571) 272-3756 effective 10/15/2004 . The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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